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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Thomas-McCants Media, Inc.

Serial No. 76462525

Sara A. Centioni of Nexsen Pruet for Thomas-McCants Media, Inc.

Michael J. Souders, Trademark Examining Attorney, Law Office 115 (Tomas V. Vlcek, Managing Attorney).

Before Walters, Grendel and Kuhlke, Administrative Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Thomas-McCants Media, Inc. has filed an application to register on the Principal Register the mark shown below for "organizing exhibitions for promoting minority owned businesses," in International Class 35.¹ The application includes a disclaimer of BLACK EXPO apart from the mark as a whole and applicant has submitted a claim of acquired

¹ Serial No. 76462525, filed October 23, 2002, based on use of the mark in commerce, alleging first use and use in commerce as of January 1, 1996.

distinctiveness under Section 2(f) of the Trademark Act, 15 U.S.C. §1052(f).



The examining attorney refused registration, *inter alia*, under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), on the ground that applicant's mark is merely descriptive in connection with its services. Applicant responded by entering a disclaimer of BLACK EXPO and submitting an amendment seeking registration under Section 2(f) of the Act based on substantially exclusive and continuous use of the mark in commerce for more than five years. The examining attorney continued the descriptiveness refusal; rejected the disclaimer as unacceptable because the design element is minimal and, thus, it is a disclaimer of the entire mark; and found the Section 2(f) claim insufficient. Applicant responded, arguing that the disclaimer is acceptable and submitting a signed copy of its Section 2(f) declaration along with evidence of use of its mark on its website. The examining attorney issued a final refusal on the ground of mere descriptiveness and stated that the declaration and evidence are insufficient to establish acquired distinctiveness. Applicant filed a

request for reconsideration which was rejected by the examining attorney.

Applicant has appealed. Both applicant and the examining attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

The examining attorney contends that the words BLACK EXPO merely describe exhibitions with a targeted audience of black consumers; that applicant has conceded that the term BLACK EXPO is merely descriptive, if not generic; that the mark "does not possess such a distinctive degree of stylization that the presentation of the term distinguishes the applicant's services" (brief, unnumbered p. 5); and that, in view of the highly descriptive nature and the minimal degree of stylization of the mark, the Section 2(f) declaration and evidence of record is insufficient to establish acquired distinctiveness. In support of his position, the examining attorney submitted dictionary definitions of "black" and "expo" and excerpts from Internet websites showing third-party use of the term "black expo."

Applicant concedes that the term BLACK EXPO is at least merely descriptive in connection with its identified services, but contends that its mark as a whole is presented in a sufficiently distinctive stylized form to permit registration; and, furthermore, that it has established that

its mark has acquired distinctiveness in connection with the identified services.²

The test for determining whether a mark is merely descriptive is whether it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of the product or service in connection with which it is used, or intended to be used. *In re Engineering Systems Corp.*, 2 USPQ2d 1075 (TTAB 1986); *In re Bright-Crest, Ltd.*, 204 USPQ 591 (TTAB 1979). It is not necessary, in order to find that a mark is merely descriptive, that the mark describe each feature of the goods or services, only that it describe a single, significant quality, feature, etc. *In re Venture Lending Associates*, 226 USPQ 285 (TTAB 1985). Furthermore, when the mark involves more than a single term, we must consider whether the combination of the terms creates a distinctive composite negating the mere descriptiveness of the component terms. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1372 (Fed. Cir. 2004).

² Early in the examination of the application, the examining attorney also refused registration under Section 2(d) of the Act based on several registrations. This refusal was later withdrawn. Applicant argues that the Section 2(e)(1) refusal is inconsistent with the examining attorney's withdrawal of the Section 2(d) refusal following applicant's argument that its design elements sufficiently distinguish its mark from the cited registrations. In response, the examining attorney noted that the previously cited registrations contain other matter, are registered on the Supplemental Register or under Section 2(f), and at least one registration also includes a disclaimer of BLACK EXPO. The withdrawal of the Section 2(d) refusal is neither legally nor logically inconsistent with the refusal before us in this appeal and, thus, applicant's argument is not persuasive.

We begin by noting that applicant entered a disclaimer of the term BLACK EXPO and amended its application to seek registration under Section 2(f) in its response of November 2, 2003. Neither of these amendments to the application was made in the alternative. These amendments, alone, are essentially applicant's concession that the term BLACK EXPO is, at least, merely descriptive in connection with the identified services. However, we also note applicant's express statements about the term BLACK EXPO in this same response that "the words BLACK EXPO are descriptive and have become generic for the associated services" (p.2) and that "applicant's attorney respectfully submits that the phrase is descriptive and generic for exhibitions of the goods and services of minority-owned businesses" (p.3). Moreover, even if applicant had not conceded the mere descriptiveness of the term BLACK EXPO, the numerous third-party Internet website excerpts submitted by the examining attorney clearly show the merely descriptive use of the term BLACK EXPO in connection with marks for services the same as, or very similar to, those of applicant. This evidence supports the conclusion that the term BLACK EXPO is merely descriptive in connection with the identified services. In addition, the large number of third parties referring, on many different websites, to fairs and expositions directed to African Americans as "black expos" leads us to the conclusion that

the term BLACK EXPO is highly descriptive in connection with applicant's identified services.

Applicant contends in its brief that the design element is sufficiently distinctive to warrant registration of its mark on the Principal Register for the identified services. However, applicant has amended its application to assert a Section 2(f) claim with respect to the mark as a whole, which is, again, essentially, applicant's concession that the mark as a whole is merely descriptive, *i.e.*, that the design element is insufficient to render the subject matter herein inherently distinctive.

Without this concession and putting aside, hypothetically, applicant's Section 2(f) claim for the moment, the question before us would be whether applicant is entitled to registration because its asserted mark is a distinctive display of unregistrable and disclaimed matter. In this regard, although a descriptive word or composite of words may not be registrable, a distinctive display of the words is registrable in the same way as any distinctive picture. *In re Clutter Control Inc.*, 231 USPQ 588 (TTAB 1986); and J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* §11:30 (Fourth Edition, June 2006). "In other words, a display of descriptive, generic or otherwise unregistrable matter is not registrable on the Principal Register unless the stylization of the words or the

accompanying design features of the asserted mark create an impression on purchasers separate and apart from the impression made by the words themselves, or unless it can be shown by evidence that the particular display which applicant uses has acquired distinctiveness." *In Re The American Academy of Facial Plastic and Reconstructive Surgery*, 64 USPQ2d 1748 (TTAB 2002) and cases cited therein. See also, *In re Miller Brewing Company*, 226 USPQ 666, 668 (TTAB 1985) (display of "Lite" for beer held not inherently distinctive, but composite mark registrable on the basis of acquired distinctiveness).

As the Board noted in *American Academy*, *supra*, "composites [that are inherently distinctive] contain presentations of the wording that are so inventive, striking, unique or distinctive in character as to make the composite registrable." In the case before us, the mark depicts the words BLACK EXPO in plain block lettering that is neither striking, unique nor distinctive in character. The only stylization consists of the curls at two of the opposing ends and vague curve of the "X," the slight increase in size of the letters of BLACK from left to right, and the very slight "fuzziness" of the "O" in EXPO. Considered together, these minor design elements do not render the mark distinctive. Neither the slight change in the size of the letters of BLACK nor the very slight

fuzziness of the "O" in EXPO is discernible without close inspection. Similarly, the "X" is the same size as the other letters in EXPO and the stylization of this single letter in the context of the nine letters comprising the mark is minimal. Thus, we would find the stylization insufficient to render applicant's composite mark distinctive despite the merely descriptive nature of the words BLACK EXPO.

We turn now to applicant's Section 2(f) claim of acquired distinctiveness. It is applicant's burden to prove acquired distinctiveness. *Yamaha International Corporation v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 6 USPQ2d 1001, 1006 (Fed. Cir. 1988); *In re Hollywood Brands, Inc.*, 214 F.2d 139, 102 USPQ 294, 295 (CCPA 1954) ("[T]here is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant"). "[L]ogically that standard becomes more difficult as the mark's descriptiveness increases." *Yamaha*, 6 USPQ2d at 1008.

A claim that applicant has been using the subject matter for a long period of substantial and exclusive use may not be sufficient to demonstrate that the mark has acquired distinctiveness. See *In re Gibson Guitar Corp.*, 61 USPQ2d 1948, 1952 (TTAB 2001) (66 years of use). The exact kind and amount of evidence necessarily depends on the

circumstances of the particular case. In this case, as proof of acquired distinctiveness, applicant submitted the declaration of its vice president, Darren Thomas, that the mark has been in use in commerce in connection with the identified services for more than five years preceding the date of the declaration. Applicant also submitted a copy of a single website page, which appears to be applicant's home page. It includes a description of applicant and its business and the mark is displayed in the top left-hand corner of the page.

In view of the very highly descriptive nature of the words BLACK EXPO and the minimal stylization of those words, applicant's evidence of acquired distinctiveness is insufficient to show that the applied-for mark has come to be recognized as an indication of origin of the services in applicant. Aside from the fact that its website may be accessed by persons worldwide, we have no evidence of the number of visitors to the site, the extent of applicant's other advertising, its revenues, what percentage of the relevant market its revenues represent, or any indication that consumers recognize the applied-for mark as a trademark. Therefore, we conclude that applicant has failed to meet its burden of demonstrating acquired distinctiveness.

Decision: The refusal to register under Section 2(e)(1) is affirmed. The applied-for mark as a whole is merely descriptive and applicant has not established, under Section 2(f), that it has acquired distinctiveness.